UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,478	03/13/2001	Makoto Suzuki	1614.1135	8768

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EXAMINER
JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/804,478	SUZUKI, MAKOTO
	Examiner	Art Unit	
	Alexander Jamal	2643	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 January 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) *2,7-14 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,15-19 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
  application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment (1-5-2005)

1.   Examiner notes that an advisory action was sent in response to the 1-5-2005 amendment

because the RCE filing had not yet been noted in the examiner's system.

2.   The following office action is in response to the RCE (Request for Continued

Examination) filed 1-10-2005 and the amendment filed 1-5-2005.

3.   Examiner acknowledges that claims 1,6,18,19,21 have been amended and claims 2,7-14,

and 20 have been cancelled.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   **Claims 1,3,4,6,15,16,18,19** rejected under 35 U.S.C. 102(b) as being anticipated by

Walsh et al. (5642410).

As per **claim 1,** Walsh discloses a device (phone management system) comprising

a managing part (application software) that manages functions and information in a

manner linked to a plurality of using situations. The software will detect various

parameters from the caller and manage the transfer of information to/from the caller (Col

5 line 57 to Col 6 line 11). The example describes multiple using situations (student

grade data and charity contribution information). The device further comprises a switch

usable by the caller to set a specific using situation (Col 9 lines 7-14). In the example provided by Walsh, the student grade data could be the business mode, and the charity contribution could be the personal mode (or vice-versa). The 'touch tone input keyed in by the caller' is a switch by which the user may trigger a specific using situation. The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (Col 9 lines 42-53). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user.

As per **claim 6,** claim rejected for same reasons as rejection of claim 1. Additionally, a detector detects several pieces of 'mode -information' (example: caller's number) to set a specific using situation (Col 9 lines 7-14). The device further comprises a control part (software) that will automatically select the appropriate function and information depending on the using situation, and make the information available to the user (Col 9 lines 42-53). Once a rule has been met (for example: by activating the switch), then the appropriate application and information are triggered and presented to the user.

As per **claim 18,** Walsh discloses information terminal equipment that includes a computer using a computer readable medium that stores a program comprising a managing means (application software) that manages functions and information in a

manner linked to a plurality of using situations. The software will detect various

parameters from the caller and manage the transfer of information to/from the caller (Col

5 line 57'to Col 6 line 11) as described in the rejections of claims 1 and 6.

As per **claim 19,** claim rejected for same reasons as rejections of claims 1,6,18.

As per **claim 3,** In Walsh's terminal the accounting destination is dependant upon

which mode has been triggered by the caller. The example shown disclosed (Col 7 lines

35-55) describes the accounting (for example: storing and using the caller's number) used

in both a business and private mode.

As per **claim 4,** Walsh's terminal comprises a display with a 'Windows' type

operating system on a local or remote computer (Col 5 lines 62-65) upon which

information of the selected function can be automatically displayed such that it may be

used by the caller.

As per **claim 15,** in Walsh's terminal the accounting destination is dependant

upon which mode has been triggered by the caller. The example shown disclosed (Col 7

lines 35-55) describes the accounting (for example: storing and using the caller's number)

used in both a business and private mode.

As per **claim 16,** Walsh's terminal comprises a display with a 'Windows' type

operating system on a local or remote computer (Col 5 lines 62-65) upon which

information of the selected function can be automatically displayed such that it may be

used by the caller or user (Col 7 lines 15-30).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claims 5,17** rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al.

(5642410) as applied to claims 1 and 6 above, and further in view of Bijman (6047062).

As per **claims 5,17,** Walsh discloses applicant's claims 1 and 6, but does not

specify that the managing part automatically updates the data that depends upon the using

situation and is not already included in the database.

Bijman teaches a method of automatically updating information stored in a

database used in a telephone system (speed dialing system). He teaches the advantage of

saving the user the trouble of manually updating the database (Col 1 lines 14-30) by

having the phone system automatically add data (a new phone number) to the database.

It would have been obvious to one of ordinary skill in the art at the time of this

application to have the managing part automatically update the appropriate database for

the advantage of saving the user the trouble of manually updating the database.

8.   **Claims 21-26** rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al.

(5642410), and further in view of Shaffer et al (6477374).

As per **claims 21,25,** Walsh discloses claims 21,25 for the same reasons as the rejections of claims 1 and 6, but does not specify that the terminal equipment detects the using situation based upon time and position information.

Shaffer teaches a device (cellular phone) system that cross references a date and time (to reference a time the unit inherently comprises a timer) with a user's location so that a call may be routed or forwarded (ie. a different using situation is setup) based upon a user's location (Col 2 line 45 to Col 3 line 7). He teaches the advantage that a user may be more easily tracked down even if he/she forgot to leave a forwarding number (Col 2 lines 23-43), as well as the advantage of more efficient call routing (Col 1 lines 44-55). It would have been obvious to one of ordinary skill in the art at the time of this application to detect a user's position in order to set the using state (call routing or forwarding) for the advantage of being able to more easily track down a user and being able to more efficiently route or handoff the call (the handoff is more efficient because the recipient of the call will have the appropriate application up and running as the caller is connected to the recipient).

As per **claims 22,23,** Walsh discloses a middleware program that sets up only the appropriate application based on the using situation (Col 6 lines 5 to 40). This will ensure that only the appropriate functions will be available (and information displayed) in both the personal and business modes.

As per **claim 24,** Walsh's system handles telephone numbers (the system responds based upon the caller's number). One of the functions of the device is a set of

standard telephone functions implemented by telephone 12 (part of the device) (WALSH:

Fig. 1).

As per **claim 26,** Walsh discloses a telephone (comprising components 15,12,10

in Fig. 1). However he does not disclose that the telephone is mobile.

Shaffer discloses a mobile telephone (Col 2 lines 45-60). It would have been

obvious to one of ordinary skill in the art at the time of this application that Walsh's

telephone system could be made mobile for the purpose of allowing the user to use the

device in multiple locations (or while moving).

Response to Arguments

9.   Applicant's arguments filed 1-5-2005 have been fully considered but they are not

persuasive.

As per applicant's arguments regarding the Walsh (5642410) reference not

disclosing 'managing functions of the apparatus' in a manner linked to "a plurality of

using situations of the apparatus" of claims 1,6,18,19 (remarks page 6), or the 'switch'

used to set the mode of the apparatus. Examiner reads the apparatus as the complete

phone/computer device of Walsh Fig. 1. The computer portion of the apparatus will

manage functions and information (perform in a certain 'mode') based upon various

triggers. These triggers may include any aspect of a phone call (note the state machine in

WALSH: Col 12 lines 10-50). The phone call may be made by the user of the apparatus

(WALSH Col 9 lines 7-12). In such a case the act of dialing a number (via the phone

portion of the apparatus) or 'keying in' touchtones comprises a switch by which the user

may set the 'mode' of the computer portion of the apparatus.

As per applicant's arguments (remarks page 7) regarding the Walsh reference

disclosing the detection of the mode based upon mode information. Examiner reads

'mode information' as any input (such as the telephone triggers for example) that are

used to set the 'mode' of the device.

As per applicant's argument regarding claim 3 (remarks pages 7-8). In Walsh's

terminal the accounting destination is dependant upon which mode has been triggered by

the caller. The example shown disclosed (Col 7 lines 35-55) describes the accounting

(for example: storing and using the caller's number) used in both a business and private

mode. The 'accounting' of the system is the use of information received or transmitted

via the telephone with the software programs of the computer, depending upon the

'mode' of the device.

As per the arguments concerning the use of the Bijman (6047062) reference to

reject claims 5 and 17 (remarks page 8), Bijman teaches a method of automatically

updating information stored in a database used in a telephone system (speed dialing

system). Bijman teaches the advantage of saving the user the trouble of manually

updating the database (Col 1 lines 14-30) by having the phone system automatically add

data (a new phone number) to the database. Walsh's apparatus comprises a telephone

system. When the telephone system makes or receives a call, the call information

(WALSH Col 7 lines 15-35) is utilized with the mode-based computer database portion

of the apparatus. Walsh's device (comprising the telephone system) in view of Bijman's

teachings comprise a mode-based system that automatically adds call data (which is used in the database depending on the mode (WALSH: Col 7 lines 26-29)) to the database.

As per the arguments regarding the rejection claims 21-26 with the Shaffer et al (6477374) reference, the examiner contends that the Shaffer reference pertains to a telecommunications system (device) that may enter a different 'mode' by performing different functions based upon the time or location. When combined with the Walsh's apparatus (which also comprises a telecommunications system), the time and location become additional triggers. Examiner notes that Walsh (Col 9 lines 10-15) does disclose the use of the time of day as a trigger to set the mode of the device, and examiner contends there is motivation (as specified in the rejections above) to add the additional time-location trigger taught by Shaffer to Walsh's apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9315 for After Final communications.

AJ
February 23, 2005

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